UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,670	04/05/2001	Moshe Brody		6750

7590 05/25/2005

Moshe Brody
Rehov Ovadia Ha-Navil 6
Kfar Sava, 44342
ISRAEL

EXAMINER	
PYZOCHA, MICHAEL J	
ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,670	BRODY, MOSHE	
	Examiner	Art Unit	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-9 and 11-33 are pending.

2. Amendment field 05/05/2005 has been received and considered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9, 11-23, 31-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The rejected claims relate to an information stream with personalization incorporated within it which is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. These claims also contain nonfunctional descriptive material, which merely describes the contents of the data.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-5, 11, 17, 23, 31-33 are rejected under 35 U.S.C. 102(a) as being anticipated by Yahoo Games (hereinafter Yahoo).

As per claim 1, Yahoo discloses in an information stream associated with deliverable published software from a software publisher to a customer, an arrangement for software protection comprising a personalization, said personalization incorporated into the information stream by the software publisher prior to delivery of the published software to the customer and prior to receipt of the published software by the customer and containing pre-existing personal information fundamentally related to the customer (see Yahoo page 12 where the personalization is the name and rating).

As per claim 2, Yahoo discloses the deliverable published software is intended to execute on a plurality of computers, and wherein said personalization is not fundamentally related to any

specific computer of the plurality (see Yahoo page 2 and page 12).

As per claim 3, Yahoo discloses the deliverable published software is intended to execute on a plurality of computers, each of the plurality of computers having a configuration and wherein said personalization is not fundamentally related to any specific configuration (see Yahoo page 2).

As per claim 4, Yahoo discloses the deliverable published software is intended to execute on computers belonging to a class of computer, and wherein the deliverable published software executes in substantially identical functional form on substantially all computers of the class of computer (see page 2 where Java runs on the PC class of computers).

As per claim 5, Yahoo discloses the personalization is not associated with, and does not activate, any usage restriction on the deliverable published software (see pages 2 and 12).

As per claim 11, Yahoo discloses the information stream contains at least one executable module, and wherein said personalization is contained within said at least one executable module (see page 12 and page 8 where the applet is the module).

As per claim 17, Yahoo discloses at least part of the deliverable published software is written in the Java language (see Yahoo page 2).

As per claim 23, Yahoo discloses the information stream contains at least one executable module operative to writing an output file containing information derived from said personalization, and wherein said information derived from said personalization in said output file is operative to being separately validated (see page 2 where all personalization including rating and games history are written to a personal file webpage).

As per claim 31, Yahoo discloses at least part of said personalization is operative to being displayed on a computer without requiring customer input of said at least part of said personalization (see page 12 where the rating requires no input by the user).

As per claims 32-33, Yahoo discloses displaying the personalization (see page 12 and page 8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

> art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo as applied to claim 1 above, and further in view of Wright (Dynamic Data Structures).

As per claims 6-7, Yahoo fails to disclose the personalization does not have a fixed address and extent within the information stream.

However, Wright teaches such limitations (see pages 2-3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Wright's method of dynamically allocating memory for the personalization of Yahoo.

Motivation to do so would have been to allow memory to be allocated at execution time (see page 2).

7. Claims 8-9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo as applied to claim 1 above, and further in view of Menezes et al.

As per claim 8, Yahoo fails to disclose authenticating the personalization.

However, Menezes et al teaches authentication (see page 25).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's authentication on the personalization.

Motivation to do so would haven been to verify that the information that was created by a user is actually from the user and that it hasn't changed (see Menezes et al page 25).

As per claim 9, the modified Yahoo and Menezes et al method discloses the personalization is in an encrypted form within the information stream (see Menezes et al page 25).

As per claim 16, the modified Yahoo and Menezes et al method discloses the information stream contains at least one executable module having an authentication, and wherein said executable module executes in a secure computer environment operative to validating the authentication (see Menezes et al page 25).

As per claim 20, the modified Yahoo and Menezes et al method discloses the computer environment operative to executing Java software (see Yahoo page 2).

8. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo as applied to claim 17 above, and further in view of Sommerer (The Java Archive (JAR) File Format).

As per claim 18, Yahoo fails to disclose the deliverable published software being contained in a Java archive.

However, Sommerer teaches the use of a JAR file (see Sommerer).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Sommerer's JAR file to hold Yahoo's computer code.

Motivation to do so would have been that the JAR format allows for compression (see Sommerer page 1).

As per claim 19, the modified Yahoo and Sommerer method discloses the JAR file is signed (see Sommerer page 1).

9. Claims 12, 15, 24-25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo as applied to claim 1 above, and further in view of Müller (A Survey of Programming Techniques).

As per claim 12, Yahoo discloses validating personalization information (see page 16-A).

Yahoo fails to disclose this validation being done in a separate module.

However, Müller teaches the use of modules (see pages 3-4).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Müller's modules to do the validation of Yahoo.

Motivation to do so would have been to enable usage of general procedures in other programs (see Müller pages 3-4).

As per claim 15, the modified Yahoo and Müller system discloses the validation module is further operative, upon not detecting a valid personalization, to initiate an action included in the group containing: (a) program termination; (b) operating the software in a demonstration mode; and (c) operating the software in a restricted mode (see Yahoo page 16-A).

As per claim 24, the modified Yahoo and Müller system discloses (a) obtaining pre-existing personal customer; (b) producing a personal information module from information fundamentally related to the said pre-existing personal information fundamentally related to the customer; and (c) producing an executable module deriving at least in part from said personal information module and incorporating at least part of said pre-existing personal information fundamentally related to the customer wherein at least one of said producing a personal information module and said producing an executable module is performed prior to delivery of the published software to the customer and prior to receipt of the published software by the customer (see Yahoo pages 16-A and 17-A).

As per claims 28-30, the modified Yahoo and Müller system discloses collecting and building customer information (see Yahoo pages 16-A and 17-A).

10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Yahoo and Müller system as applied to claim 12 above, and further in view of Pratt (US 6070254).

As per claims 13-14, the modified Yahoo and Müller system fails to disclose validating an output file and an execution module.

However, Pratt teaches validation (see column 4 lines 22-32).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Pratt's validation to validate the modified Yahoo and Müller's output and module.

Motivation to do so would have been to determine if an error has been detected which requires modification of the data (see column 4 lines 33-40).

11. Claims 21-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Yahoo and Müller system as applied to claims 12 and 24 above, and further in view of Menezes et al.

As per claim 25, the modified Yahoo and Müller system fails to disclose authenticating the personalization.

However, Menezes et al teaches authentication (see page 25).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's authentication on the personalization.

Motivation to do so would haven been to verify that the information that was created by a user is actually from the user and that it hasn't changed (see Menezes et al page 25).

As per claims 21-22, the modified Yahoo, Müller and Menezes et al system discloses encryption and decryption using a public key cryptosystem (see page 25).

12. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Yahoo and Müller system as applied to claim 24 above, and further in view of Sommerer.

As per claim 26, the modified Yahoo and Müller system fails to disclose incorporating said executable module within a Java archive; and authenticating said Java archive with an archive signature.

However, Sommerer teaches these limitations (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Sommerer's JAR file to hold the modified Yahoo and Müller system's computer code.

Motivation to do so would have been that the JAR format allows for compression (see Sommerer page 1).

13. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Yahoo, Müller and Menezes et al system as applied to claim 25 above, and further in view of Sommerer.

As per claim 27, the modified Yahoo, Müller and Menezes et al system fails to disclose incorporating said executable module within a Java archive; and authenticating said Java archive with an archive signature.

However, Sommerer teaches these limitations (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Sommerer's JAR file to hold the modified Yahoo, Müller and Menezes et al system's computer code.

Response to Arguments

2. Applicant's arguments filed 05/05/2005 have been fully considered but they are not persuasive. Applicant arguments are broken into three sections: dates of the prior art, the prior

art's anticipation of the claims and limitation of software protection in the preamble.

3. Applicant argues: the dates of Müller and certain sections of the Yahoo Games do not beat the priority date of the present application; the web pages submitted do not describe a "printed publication"; and links provided by "Internet Archive Wayback Machine" do not prove the existence of the material on the web at the specified date.

Regarding Applicant's argument that the dates of Müller and certain sections of the Yahoo Games do not beat the priority date of the present application, new printouts of these sources have been included with dates before the priority date of the present application. Also references to the undated material (Yahoo Games pages 3-6) have been removed.

Regarding Applicant's argument that the web pages submitted do not describe a "printed publication," this is merely an assertion without any support from case law and is therefore not persuasive.

Regarding Applicant's argument that links provided by "Internet Archive Wayback Machine" do not prove the existence of the material on the web at the specified date, as seen on the provided FAQs from archive.org (pages 1-2) it is shown that the likes are to pages that were active on the date of the crawl.

4. Applicant argues that Yahoo fails to disclose: data associated with deliverable published software being incorporated into the information stream and the arrangement is for software protection.

Regarding Applicant's argument that Yahoo fails to disclose data associated with deliverable published software being incorporated into the information stream, the Java Applet of Yahoo Games is the deliverable published software, which contains the personalization. This limitation and the limitation regarding software protection are part of the preamble, which was not given patentable weight.

5. Applicant argues that the limitation of software protection, in the preamble, should be given patentable weight.

Regarding Applicant's argument that the preamble should be given patentable weight, in the instant application the preamble recitations are merely statements of the functionality and give the claim no further structure. Also, this argument is a mere assertion that the preamble should be given patentable weight without any references to specific case law.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER